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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/676,700

09/30/2003

Brian V. Belmont

042390.P16793

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05/05/2009

INTEL/BSTZ

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EXAMINER

KARIKARI, KWASI

ART UNIT

PAPER NUMBER

2617

MAIL DATE

DELIVERY MODE

05/05/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/676,700 | Applicant(s) BELMONT ET AL. | |
| | Examiner KWASI KARIKARI | Art Unit 2617 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,7-9,12,14-16,19,21-23,26 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 5, 7-9, 12, 14-16, 19, 21-23, 26 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/18/2009 has been entered.

Response to Arguments

2. Applicant's arguments, filed on 02/18/2009 with respect to claims 1-2, 5, 7-9, 12, 14-16, 19, 21-23, 26 and 28 in the remarks, have been considered but are moot in view of the new ground(s) of rejections.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 8-9, 12 and 14 *are* rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 8 recites a computer readable medium whereby the specification specifically mentions an example of computer readable medium to include transmission forms, such as, carrier waves (see Paragraph [0020]) which do not fall under statutory subject matter.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2, 5, 7-9, 12, 14-16, 19, 21-23, 26 and 28 are rejected under 35

U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The claim(s) contains subject matter which was not described in the specification in

such a way as to reasonably convey to one skilled in the relevant art that the

inventor(s), at the time the application was filed, had possession of the claimed

invention. The amended claimed limitations “initially receiving an incoming call at a cell

phone prior to sending a notification of the incoming call to a personal data processing

device external to the cell phone”, in claims 1, 8, 15 and 22 are not clearly described in

the specification as originally filed and this constitute new matter. For examination

purposes, the Examiner would interpret the rejected claimed limitations in the broadest

scope of the Applicant's invention. Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time

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any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 2, 5, 8, 9, 12, 15, 16, 21-23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson (U.S. 20040266399 A1), (hereinafter Simpson) in view of Lin et al., (US 7,184,527), (hereinafter, Lin).

Regarding claims 1, 8, 15 and 22, Simpson discloses a method /apparatus/machine readable storage/system for managing a cell phone call (= wireless telephone 100 communicates with system 604, see Par. 0029) comprising:

initially receiving an incoming call at a cell phone prior to sending a notification of the incoming call to a personal data processing device external to the cell phone (= display of Caller ID on the wireless telephone 100 when incoming call is received; and a signal is sent back to the auto answer unit on system 604, see [0029-30])

sending the notification of the incoming call on the personal data processing device (= wireless telephone 100 is connected and in communication with system 604; and network 602; wireless telephone 100 set up and provide selected status announcements from wireless telephone user to a caller; and incoming call on wireless telephone which is connected with system 604 via network 602, see Pars [0029-30] and Fig. 6; whereby the “personal data processing device” is being associated with system

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604 which is communication with the wireless telephone 100) the personal data processing device coupled to the cell phone via a connection (= wireless telephone 100 is connected with system 604 via network 602, see Par. 0029; and Fig. 6);

retrieving caller identification ID and information associated with the incoming call (= calling number or Caller ID is displayed in the display 102, see Page 3, line 0022),

examining one or more of predefined preferences of a user of the cell phone, a calendar of the user indicating availability of the user, and real-time instructions from the user, wherein examining includes determining whether a configuration is set such that a response is automatically sent to the incoming call (= personal announcement option/ list of announcement action, see Pars. 0007, 0016-17, 0024-26 and 0029-3); and

managing the incoming call according to the one of the predefined preferences and the real-time instructions, wherein the one of the predefined preferences and the real time instructions includes at least one of forwarding the incoming call, requesting a sender of the incoming call to send an instant message, and responding to the incoming call with a voicemail message (= personalized announcement/option, e.g., I am in the meeting right now, see Pars. 0016 and 0030), wherein the responding to the incoming call is adjusted according to one or more of the predefined preferences, the calendar, and the real-time instructions (= selection of real time personal message/announcement to play to a caller, see Pars. 0016, 0023, 0028 and 0031).

Simpson explicitly fails to disclose, "wherein the caller ID and the information are retrieved from a plurality of sources".

However, **Lin**, which is an analogous art, equivalently teaches “wherein the caller ID and the information are retrieved from a plurality of sources” (= CPC service allows a user to monitor incoming calls to multiple phone lines from any location that has Internet access....”, see col. 3, lines 15-23).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Lin and Simpson for the benefit of achieving a communication system that allow a user to monitor incoming call from any location that has internet access.

Regarding claims 2, 9, 16 and 23, Simpson further discloses a method according to claims 1,8,15 and 22 wherein retrieving the information associated with the incoming call further comprises at least one of: retrieving the information from the cell phone (= wireless telephone displays the Caller ID in the display, see Page 2, line 0016); retrieving the information from the data processing device; and retrieving the information from a source coupled to the data processing device.

Regarding claims 5, 12 ,19, 26, Simpson further discloses a method according to claim 1,8,15 and 22 wherein responding to the incoming call with the voicemail message further comprises selecting one of a plurality of voicemail messages as the appropriate response (= the wireless telephone user can select a specific voice mail announcement or a general announcement that allows wireless phone to answer on his/her behalf, see Page 2, line 0016).

6. **Claims 7,14, 21 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson in view of Lin and further in view of Ihara et al., (U.S 20040185915 A1), (hereinafter Ihara).**

Regarding **claims 7, 14, 21 and 28**, the combination of **Simpson and Lin** fails to teach according to claims 1,8,15 and 22 wherein the signal comprises an Attention Command (AT) signal.

However, **Ihara**, which is an analogous art, teaches a silent alerting capability for a Bluetooth hand-free device (see Page 1, line 0004). Ihara further discloses that the user answer at Fig. 3, item 328 initiates an “attention” command or “AT” command from HF device to AG device, see Page 3, line 0025).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Ihara with Simpson and Lin for the benefit of achieving a silent alert communication system.

CONCLUSION

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached form PTO-892 for cited references and the prior art made of record.

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as

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well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. SEE MPEP 2141.02 [R-5] VI. PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING DISCLOSURES THAT TEACH AWAY FROM THE CLAIMS: A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). >See also MPEP §2123.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kwasi Karikari whose telephone number is 571-272-8566. The examiner can normally be reached on M-T (9am - 7pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Appiah can be reached on 571-272-7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8566. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/KWASI KARIKARI/
Examiner, Art Unit 2617

/Charles N. Appiah/
Supervisory Patent Examiner, Art Unit 2617